

Appl. No. : 10/762,716
Filed : January 22, 2004

REMARKS

In the Office Action mailed March 23, 2005, the Examiner maintained rejections of Claims 9-13 as anticipated by Cannavino (U.S. Patent No. 6,264,569) and Claims 14 and 15 as rendered obvious over the same reference in view of Heubl (U.S. Patent No. 5,499,949).

"Foot Deck"

Applicant submits that the Examiner misunderstood at least a portion of Applicant's arguments; the misunderstood argument is that the reference failed to teach the recited components and that the Examiner's application of the prior art to the claim language reflects a strained reading of both the claims and the prior art. First, the recitation of the "foot deck" is not a recitation of the intended use; it is an element of one embodiment of the claimed invention. Accordingly, analysis under an "intended use" theory is inapposite. Second, the recitation of the "foot deck" is not a process of making so analysis under a "method of making" theory is equally inapposite.

Furthermore, there is a reason that Cannavino describes elements 27 and 28 as "seat supports." The "seat supports" as designed and positioned to be sat upon. They are no more "foot decks" than the support beam 16 is a "foot deck" simply because it can be stood upon if a user so chooses. Just because a component can support a user in a standing position does not make that component a "foot deck" when the teaching of the prior art is properly taken into consideration. Such an analysis of "possibilities" ignores the specific teachings of the prior art as well as specific limitations of the claims. The Examiner is misconstruing the prior art and the claim language in maintaining the rejection of Claims 9-13.

Collapsible Frame

With regard to Claim 10 and the frame being collapsible for storage, the Examiner indicates that the resilient members can be removed from the frame such that the spring board deck can be removed from the frame for storage. Applicant fails to understand from the teachings of the prior art reference how this makes the frame collapsible for storage. The frame seems to remain in an uncollapsed A-frame configuration. Even the Examiner's argument for why the frame is collapsible for storage fails to address where the prior art taught that the frame was collapsible.

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Handlebars

With regard to the handlebars recited by Claim 12, again the Examiner misconstrues both the prior art and the recited claim limitation. Simply stating that an element can be used in a manner contrary to the manner described in the prior art does not make it such a component. Simply because a bike rider can lean forward and grab a wheel fender to turn the front wheel would not make a bike front fender a "handlebar." Furthermore, where the prior art already defines a member as a "handle," to call a completely different element a "handlebar" when that element is not taught as a handlebar contorts the teaching of the prior art. This is especially the case where that element cannot possibly be used as a handlebar – the crossing member 16 is located about one to two feet directly beneath the user when the user is sitting on the device; if, as suggested by the Examiner, the user were to stand on the device, there is absolutely no chance that the user could ever use the crossing member 16 as a handlebar.

Obviousness

Finally, Applicant agrees that the test for obviousness requires the prior art to have suggested the claimed invention. Nevertheless, if the prior art fails to make the suggestion, the Examiner can only be relying upon hindsight in combining the prior art in a manner that renders the claimed invention unpatentable. Furthermore, the Examiner cannot ignore the teachings of both references when combining the references. In this case, the Examiner fails to address the criticality of the motion being achieved by the Cannavino reference and the importance placed upon the motion by the inventor of Cannavino. Altering the location of the seat support 27, 28 would alter the motion of Cannavino, which would render it unusable for its intended purpose. Such an alteration in arriving at an obviousness combination is impermissible. Moreover, neither of these references has any relation to the skateboard trainer art and, therefore, the references are not in the field of applicant's endeavor.

Claims 9-15 Have Been Cancelled

Although Applicant disagrees with the Examiner's rejections for the reasons expressed above, Applicant must respond to the Final Office Action in a manner that will remove the basis for all rejections. Thus, Applicant is canceling Claims 9-15. Applicant does not intend to acquiesce to the rejections and reserves the right to pursue claims at least as broad as Claims 9-15

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in a continuation application because Applicant believes these claims to be patentable over the prior art of record.

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, issuance of a Notice of Allowance is most earnestly solicited.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney in order to resolve such issue promptly. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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By: 

Robert J. Ropy
Registration No. 44,304
Attorney of Record
Customer No. 20,995
(949) 760-0404

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